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UNITED STATES DISTRICT COURT

NORTHERN DISTRICT OF CALIFORNIA

INTERTRUST TECHNOLOGIES CORPORATION, a Delaware corporation, Plaintiff, v. MICROSOFT CORPORATION, a Washington corporation, Defendant. AND COUNTER ACTION.	Case No. C 01-1640 SBA (MEJ) Consolidated with C 02-0647 SBA **MEMORANDUM OF POINTS AND AUTHORITIES OF PLAINTIFF INTERTRUST TECHNOLOGIES IN OPPOSITION TO MICROSOFT MOTION FOR SUMMARY JUDGMENT ON INDEFINITENESS AND IN SUPPORT OF CROSS-MOTION FOR SUMMARY JUDGMENT** Date: May 30, 2003

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I. INTRODUCTION

The word "secure" is widely used in the computer security field. It appears in the claims of hundreds of patents, including many issued to Microsoft. It is used in product documentation, technical literature and white papers published by Microsoft and others. It is defined in numerous technical dictionaries, including the Microsoft Computer Dictionary.

Yet Microsoft now seeks to convince the Court that the word "secure," when used in InterTrust patent claims, is so vague that it renders those claims indefinite as a matter of law.

InterTrust's patents are presumed valid, and Microsoft carries a heavy burden of establishing, by clear and convincing evidence, that one of ordinary skill in the art would be unable to understand or apply the claims. This burden is considerably heavier where, as here, the disputed term is widely used by the defendant, by others in the field, and in numerous patents.

Microsoft cannot possibly carry its burden. It relies on a test manufactured by its expert witness, Professor Mitchell, for the purpose of this litigation, a test never applied to any other document, a test that is so stringent that it is failed by Microsoft patents, third party patents and industry documents. In fact, Professor Mitchell's published papers fail his own test! There is no evidence that any document ever created anywhere, by anyone, can pass Prof. Mitchell's test.

InterTrust's patents use the term "secure" in a manner consistent with the generally understood use of that term in the industry. Microsoft uses the term in exactly the same manner in its own patents and documents. Microsoft cannot carry its burden. InterTrust therefore seeks summary judgment that the disputed claims are definite.

II. FACTS

A. "Secure" and "Security" Are Widely Used in the Computer Security Field.

The terms "secure" and "security" are widely used in the computer security field to refer to the application of one or more mechanisms to protect a computer system or process against attack. Mitchell Decl., 4:18-19; Reiter SJ Decl., ¶¶ 5-7.[1]

[1] Declaration of Dr. Michael Reiter in Opposition to Microsoft Motion for Summary Judgment on Invalidity and In Support of InterTrust's Cross-Motion.

1. General use in the industry.

a. Dictionary definitions. "Secure" and "security" are defined in many computer dictionaries. Those definitions use different language, but consistently focus on protection against a type of attack or misuse. Reiter SJ Decl., ¶ 7(a); McDow Decl., ¶ 5 and Ex. C.[2]

b. Microsoft and third party documentation. Microsoft routinely uses the words "secure" and "security" to refer to its own products. Reiter SJ Decl., ¶¶ 14-22, 27. For example, Microsoft describes how its Windows operating system was evaluated under a standard security methodology, including statements such as "Windows 2000 meets the evaluation requirements by providing secure directory access and administration." This document also describes features such as "secure connectivity," "secure policy application," and "secure networked environment." Reiter SJ Decl., ¶ 16 and Ex. J. This use of "secure" to describe products or product features is common in Microsoft documents. Reiter SJ Decl., ¶ 27 and Ex. C, Page Decl., Ex. C.

Dr. Reiter analyzed publicly-available Microsoft technical documents that use the term "secure." They do not pass Prof. Mitchell's test. Reiter SJ Decl., ¶ 27 and Ex. C.

Microsoft's use of "secure" to refer to its products and features is not limited to public documents. In internal documents, Microsoft engineers describe products as "secure," with no apparent difficulty in understanding what the term means. These include terms that are identical or extremely similar to the terms Prof. Mitchell has decided are "unclear." Derwin Decl.,¶¶ 3-6.[3]

"Secure" is also routinely used in third party documents without definition. Reiter SJ Decl., ¶7(b) and Ex. L, Page Decl., Ex. B.

2. Use in Prof. Mitchell's papers.

Prof. Mitchell's papers use the term "secure" or "securely." Dr. Reiter applied Prof. Mitchell's test to these papers. The papers do not pass the test. Reiter SJ Decl., ¶ 26 and Ex. F.

[2] Declaration of Jeff McDow in Opposition to Microsoft Motion for Summary Judgment on Invalidity and In Support of InterTrust's Cross-Motion.

[3] Declaration of Douglas Derwin In Opposition to Microsoft Motion for Summary Judgment and In Support of InterTrust's Cross-Motion.

3. Use in other patents.

a. Microsoft patents. The term "secure" is used as an adjective or adverb describing computer products or processes in the claims of numerous Microsoft patents, including one of the patents Microsoft has asserted against InterTrust in a counterclaim in this action. McDow Decl., ¶ 6 and Ex. D; Reiter SJ Decl., ¶¶ 7(c), 28 and Ex. D.

Microsoft's patents include claims with terms such as: "secure mode," "securely stores," "secure function," "securely shared," "secure access," "secure network," "secure data," "securely integrated," "secure message" and "secure package." McDow Decl., Ex. D.

Dr. Reiter analyzed a number of the Microsoft patents. None of them passes Prof. Mitchell's test. Indeed, the Microsoft patents contain less information about what "secure" means than do the InterTrust patents. Reiter SJ Decl., ¶ 29.

b. Third party patents. Ex. E to the McDow Decl. illustrates the use of "secure" in the claims of 100 computer-related patents issued over the past year, including phrases such as "secure element," "secure server," secure environment" "secure Internet access," "secure storage device," secure data" and "secure operating system." Dr. Reiter checked several of these patents, none of which can pass Prof. Mitchell's test. None of them includes as much information about what "secure" means as do the InterTrust patents. Reiter SJ Decl., ¶¶ 30-31.

B. Recognized Methodologies Exist for Determining if Computer Products or Methods are Secure.

Dr. Reiter describes several recognized methodologies for determining if computer products are "secure," some of which are explicitly referenced in the InterTrust patents. Reiter SJ Decl., ¶¶ 13-23. Computer security professionals routinely use such methodologies to determine if products or methods are "secure," and purchasers (including the U.S. Government) routinely rely on these determinations in making purchasing decisions. Reiter SJ Decl., ¶ 13.

Dr. Reiter's Declaration includes a description of a Microsoft marketing document explaining how one such methodology was applied to Microsoft Windows, and declaring that elements of the product had been found to be "secure." Reiter SJ Decl., ¶¶ 14-22 and Ex. J.

The information included in the InterTrust patents includes guidance regarding how

security should be measured, including the statement that security should be based on a commercially reasonable standard.[4] Computer security professionals routinely apply such a standard in building security into real-world products. Reiter SJ Decl., ¶¶ 12, 18.

C. The Experts Agree on the General Meaning of "Secure" and "Security."

InterTrust and Microsoft have each proposed a definition for "secure." Those definitions are generally consistent, the primary difference being Microsoft's insistence that each of five specific properties be protected, whereas InterTrust's definition is: "One or more mechanisms are employed to prevent, detect, or discourage misuse of or interference with information or processes." This definition is definite, it is easily understood and simply applied, and provides clear guideposts for determining whether a specific system falls within its scope.

Microsoft's expert, Professor Mitchell and InterTrust's expert, Dr. Reiter, agree that "secure" and "security" have a general meaning in the field. Reiter SJ Decl., ¶ 5. In his Declaration, Prof. Mitchell explains this general meaning:

> In computer science, including the particular fields most pertinent to these InterTrust patents, "security" generally has to do with designs, techniques and mechanisms for protecting certain properties against some kinds of attack or adversarial conditions.

Declaration of Professor John C. Mitchell ("Mitchell Decl."), 4:15-17. Prof. Mitchell's deposition testimony, quoted at McDow Decl., Ex. A, § 1, is consistent with this understanding:

> A. Well, security generally has to do with guaranteeing certain properties against some kind of attack or adversarial conditions.

Mitchell I, 29:6-8.[5]

> We use the word "secure" to suggest that there are some properties being protected against an adversarial attack.

Mitchell I, 88:5-7.

> I mean, ordinarily, and almost uniformly, "security" is a term that suggests one or more properties against one or more threats where the properties and threats are determined by the context in which you use it.

---

[4] See, e.g., items 19(B) and 19(J) from Joint Claim Construction Statement, Ex. C, which contains InterTrust's evidence in support of its claim construction position.

[5] In transcript quotations, extraneous material (e.g., objections) is omitted.

Mitchell I, 117:8-12.

Professor Mitchell also testified that those of ordinary skill in the art can determine if a product is "secure" through commonly used methodologies or criteria. That testimony, which is quoted in McDow Decl., Ex. A, § 2, includes the following:

> Q. Is it ever possible to determine if a system is secure, in your opinion?
>
> A. There are compelling arguments that can be presented to substantiate a claim of security. There's a recognized set of criteria, or several proposed sets of criteria, for establishing or certifying security systems.

Mitchell I, 46:20-47:1.

> Q. So I take it that there are a range of methods that a security analyst might use to determine if a system is secure, correct?
>
> THE WITNESS: Yes. A security analyst, given a set of properties and a set of possible attacks or looking for attacks, could use a number of different methods to study a system.
>
> Q. Was that also true as of February 1995?
>
> A. I believe so.

Mitchell I, 53:11-21.

Prof. Mitchell's testimony on this issue is clear, consistent and unambiguous:

(a) "Secure" means that properties of a system are protected against attacks.

(b) To determine if a particular system is "secure," it is necessary to perform an investigation to determine what the protected properties are, what the potential attacks are, and whether the former are protected against the latter.

(c) There are recognized methodologies used to perform this investigation.

D. The InterTrust Patents Use the Terms "Secure" and "Security" Consistently with the Generally Accepted Meaning of these Terms.

Prof. Mitchell understands what "secure" means in the patents. His testimony is quoted at McDow Decl., Ex. A, § 3. Following are some of the highlights:

> A. I don't find any place in the patent where it says, "In this document, 'secure' means the following." So in that sense, I don't really see a definition of "security" here.
>
> However, the patent describes or suggests or promises a set of properties, and

they include these five properties, as I understand it.

Q. Okay. And these five properties are the properties availability, secrecy, integrity, authenticity, and nonrepudiation that are listed in the Microsoft construction for "secure," correct?

A. I believe that's what we're discussing, yes.

Mitchell I 68:25-69:11.

Were you able in some cases to determine what the patent meant by the use of the word "secure"?

A. I'm having a little trouble putting my finger on or imagining a specific case to give you as an example. But there are some passages where there are descriptions of -- that are a little more specific and give some reasonable guess as to which of these properties are relevant in that situation.

Q. Are there some passages in the '193 patent in which the word "secure" is used to refer to a subset of these five properties?

THE WITNESS: Yeah. I mean, it may be in the sense I just described.

Mitchell I, 74:20-75:10.

Microsoft's argument that "secure" is used inconsistently in the InterTrust patents is based on a mischaracterization of the patents. Thus, Microsoft points out that the InterTrust patents use a variety of adjectives to modify "secure, and argues that "the meaning of these different degrees of security is unclear." MS Memo. at 10:20. The passages cited by Microsoft, however, explicitly explain the differences between many of these terms. Thus, "truly secure" and "less secure" occur in the same sentence, with the former characterizing processing using a Secure Processing Unit whereas the latter characterizes processing using a Host Processing Environment. '193 Patent, 80:22-35. These terms are not used in isolation, but are explicitly explained and contrasted. Similarly, the '193 patent contains a passage contrasting "highly secure" encryption algorithms with "extremely secure" algorithms, and explicitly identifies each type of algorithm, including explaining circumstances under which each should be used. '193 Patent, 67:18-40. See also '193 Patent, 201:63-202:12. Again, these uses are not evidence that "secure" is meaningless, but instead include significant clarifying detail, detail that Microsoft and Prof. Mitchell ignore. Each of these passages uses the term "secure," and each of them serves as an example of the meaning of the term "secure" in the claims (e.g., both "highly

secure" and "extremely secure" algorithms are "secure.")

Prof. Mitchell understands what "secure" means in the InterTrust patents: in general it means protection of the five listed properties, but sometimes the word refers to protection of fewer than all five. This testimony is consistent with InterTrust's proposed definition of "secure" and with Dr. Reiter's testimony. Reiter SJ Decl., ¶¶ 5 and 7(d).

E. Prof. Mitchell's Declaration Establishes that the Disputed Terms Are Definite and Clear.

Prof. Mitchell understands the meaning of the disputed terms. The first claim term analyzed in his Declaration is "secure memory." He first explains what the term means:

> Thus, the "secure memory" must at least be able to store a file whose copying or moving is prevented, except as authorized.

Mitchell Decl., 20:10-18.

Prof. Mitchell thus understands that a "secure memory" must prevent unauthorized copying or moving of a file.

Prof. Mitchell next discusses use of "secure memory" in the art (Mitchell Decl., 20:20-25), then turns to descriptions of the term in the patent specification. He quotes over 30 lines of detailed description from a specification embodiment of "secure memory," including protection mechanisms and the actions prevented (e.g., information cannot be observed, interfered with or leave except under appropriate conditions).

InterTrust may not agree with Prof. Mitchell's construction of "secure memory" when that phrase is presented for construction. Nevertheless, the fact that Prof. Mitchell is able to articulate a clear definition of the term demonstrates that "secure" is not indefinite.

The next term analyzed by Prof. Mitchell is "secure container." Again, he analyzes the term, extrinsic evidence and the specification and concludes as follows:

> This method [861.58] appears to promise that it prevents anyone and anything from accessing or using certain information (by putting the information in a secure container), except as authorized by a rule. (Mitchell Decl., 26:3-6)

> The component assembly [in 912.35] is protected in at least three ways: (a) one of its elements is shielded from unauthorized access (by a secure container), (b) the record identifying the elements necessary to build the component assembly is

likewise protected . . . .(Id., 26:22-26)

This language from '683, Claim 2 . . . suggests that the 'secure container' is able to prevent 'an aspect of access to or use of' its governed items . . . .(Id., 27:22-25)

Thus, Prof. Mitchell understands "secure container" similarly in all three claims: the container shields or protects its contents from access or use.

Similar points can be made about Prof. Mitchell's discussion of the other purportedly indefinite claim terms: in each case his Declaration reveals he understands what the term means.

Prof. Mitchell's opinion that "secure" is indefinite is not based on any failure to understand the claim terms, but instead on InterTrust's failure to meet a ten-part test that takes up two pages in his Declaration. Mitchell Decl., 9:3-11:4. However, Prof. Mitchell admitted in his deposition that he had created this test for purposes of this litigation, after deciding that more standard methodologies were too "technical" for the Court to understand. Mitchell II, 223:13-16. McDow Decl., Ex. A, § 5, Reiter SJ Decl., ¶¶ 2, 24. Tellingly, Prof. Mitchell made no attempt to apply his test to any other document. See Mitchell testimony in McDow Decl., Ex. A, § 6.

Not surprisingly, when Prof. Mitchell's test is applied in other contexts, it turns out that Microsoft's security-related technical documentation also fails his test, Microsoft's patents fail his test, third party patents fail his test, and Prof. Mitchell's own computer security papers fail his test. Reiter SJ Decl., ¶¶ 25-32 and Exs. C-F.

Moreover, Prof. Mitchell's application of this test is revealing. For example, he does not feel that InterTrust's "secure memory" meets test item (2), since "There is no indication, e.g., of what information in addition to the file is to be stored." Mitchell Decl., 23:8-9.

The relevant claim (193.1) states that the secure memory contains a digital file. It does not require any other information, and Prof. Mitchell does not argue that the claim includes any such requirement. Mitchell II, 292:17-293:17. Thus, InterTrust fails his test because the claim does not identify other information the presence of which is not required by the claim.

Similarly, Prof. Mitchell testifies that item (3) from his test hasn't been met since "There is no clear indication of whether the stored information's availability, integrity or authenticity is

to be protected." Mitchell Decl., 23:10-11. Earlier in the Declaration, however, he noted that the claim requires that copying or moving the file be prevented, except as authorized. Mitchell Decl., 19:10-11. Similarly, he understands specification references to "secure memory" to mean that "a 'secure memory' is 'secure' in part because all unauthorized access to, observation of, and interference with information stored within it is prevented." Mitchell Decl., 21:11-14.

Thus, according to Prof. Mitchell, the claim and the specification embodiment clearly explain what is being protected.[6] Prof. Mitchell does not explain why it is necessary for the claim to also list other elements the protection of which is not required by the claim.

To take one last example, Prof. Mitchell finds "secure operating environment" indefinite despite the following: "The patents suggest that a 'secure operating environment' is 'secure' in part because it prevents all unauthorized access to, and observation of, and interference with data and processes within the operating environment." Mitchell Decl., 33:7-9. Despite this, Prof. Mitchell nevertheless finds the term indefinite because it doesn't pass his test.

Prof. Mitchell understands the claim terms, but argues they are unclear because they do not include enough information to pass his made-up ten-part test, including information that is clearly extraneous to the claim. The Federal Circuit has a name for analysis of this type: semantic quibbling. Rosemount, Inc. v. Beckman Instruments, Inc., 727 F.2d 1540, 1548 (Fed. Cir. 1984).[7] Microsoft cites no legal support for the proposition that a claim may be invalidated for indefiniteness based on its failure to recite extraneous details. No such support exists.

F. The InterTrust Patents Contain Significant Information About Every Element of Prof. Mitchell's Test.

Even if Prof. Mitchell's test were accepted in the industry, InterTrust's patents contain a

[6] InterTrust does not necessarily agree with Prof. Mitchell's interpretation of "secure memory" or other terms he discusses. Those terms may have to be construed by the Court in subsequent proceedings, and InterTrust will present its position on their meaning at that time. The significance of Prof. Mitchell's testimony is not that he agrees with InterTrust's interpretation of the claims, but that he has no difficulty coming to an interpretation, thereby clearly indicating that the claims are not indefinite. That parties disagree about the meaning of the claims does not render them indefinite. See below, § III B 3.

[7] "Beckman attacks the claims as indefinite, primarily because 'close proximity' is not specifically or precisely defined. . . . [T]o accept Beckman's contention would turn the construction of a patent into a mere semantic quibble that serves no useful purpose."

wealth of detail responsive to every element of that test, detail that Prof. Mitchell ignores. Reiter SJ Decl., ¶ 38 and Ex. B, § II. Prof. Mitchell's ignorance of key passages is understandable, since InterTrust identified specification passages of greatest significance to the disputed terms, but Microsoft failed to provide this information to him. McDow Decl.,¶¶ 9-10 and Ex. A, § 8. These passages provide significant detail on the terms, including very important elements not described in the passages quoted in Prof. Mitchell's Declaration. Reiter SJ Decl., ¶¶ 44-48.

III. ARGUMENT

A. Microsoft Carries a Heavy Burden of Establishing Indefiniteness By Clear and Convincing Evidence.

InterTrust's patents carry a "strong presumption of validity," and the burden is on Microsoft to rebut that presumption with "clear and convincing evidence." Al-Site Corp. v. VSI Int'l, Inc., 174 F.3d 1308, 1323 (Fed. Cir. 1999); Intel Corp. v. Via Techs., Inc., 319 F.3d 1357, 1366 (Fed. Cir. 2003) ("Any fact critical to a holding on indefiniteness, moreover, must be proven by the challenger by clear and convincing evidence"). In ruling on Microsoft's indefiniteness defense, the Court must resolve close questions in favor of InterTrust. Exxon Research & Eng'g Co. v. United States, 265 F.3d 1371, 1380 (Fed. Cir. 2001).

B. Indefiniteness Standards.

In Exxon Research, the Federal Circuit provided an overview of the indefiniteness analysis, emphasizing the difficult burden facing a party seeking to establish that the claims of an issued U.S. Patent are invalid for indefiniteness:

> In determining whether that standard is met, i.e., whether "the claims at issue [are] sufficiently precise to permit a potential competitor to determine whether or not he is infringing," we have not held that a claim is indefinite merely because it poses a difficult issue of claim construction. We engage in claim construction every day, and cases frequently present close questions of claim construction on which expert witnesses, trial courts, and even the judges of this court may disagree. Under a broad concept of indefiniteness, all but the clearest claim construction issues could be regarded as giving rise to invalidating indefiniteness in the claims at issue. But we have not adopted that approach to the law of indefiniteness. We have not insisted that claims be plain on their face in order to avoid condemnation for indefiniteness; rather, what we have asked is that the claims be amenable to construction, however difficult that task may be. If a claim is insolubly ambiguous, and no narrowing construction can properly be adopted, we have held the claim indefinite. If the meaning of the claim is discernible, even

> though the task may be formidable and the conclusion may be one over which reasonable persons will disagree, we have held the claim sufficiently clear to avoid invalidity on indefiniteness grounds. By finding claims indefinite only if reasonable efforts at claim construction prove futile, we accord respect to the statutory presumption of patent validity and we protect the inventive contribution of patentees, even when the drafting of their patents has been less than ideal.

Exxon Research, 265 F.3d at 1375 (citations omitted).

1. Whether one of ordinary skill in the art would understand the claim.

To carry its burden, Microsoft must establish that one of ordinary skill in the art would not be able to understand the scope of the claims, read in light of the specification. North Am. Vaccine v. American Cyanamid Co., 7 F.3d 1571, 1579 (Fed. Cir. 1993). In making this determination, the Court must keep in mind that patents are not required to include information that would be understood by one of ordinary skill:

> Patent documents are written for persons familiar with the relevant field; the patentee is not required to include in the specification information readily understood by practitioners, lest every patent be required to be written as a comprehensive tutorial and treatise for the generalist, instead of a concise statement for persons in the field. Thus resolution of any ambiguity arising from the claims and specification may be aided by extrinsic evidence of usage and meaning of a term in the context of the invention. The question is not whether the word "substantially" has a fixed meaning as applied to "constant wall thickness," but how the phrase would be understood by persons experienced in this field of mechanics, upon reading the patent documents.

Verve, LLC v. Crane Cams, Inc., 311 F.3d 1116, 1119-20 (Fed. Cir. 2002).

2. Use of general terms to describe a range of circumstances does not render claims indefinite.

Claims may use general terms to describe a range of circumstances, as long as those of ordinary skill in the art would be able to understand the terms. In Exxon Research, the Federal Circuit found a claim term not indefinite despite the fact that the presence of the claim element would depend on external factors, including the conditions chosen for the claimed process:

> Although the patent does not quantify the "period sufficient" limitation by reference to any specific period or range of periods, it does not leave those skilled in the art entirely without guidance as to the scope of that requirement. . . .
>
> * * *
>
> Because the patent makes clear that the period in question will vary with changes in the catalyst and the conditions in which the process is run, we conclude that the claim limitation is expressed in terms that are reasonably precise in light of the

subject matter.

Exxon Research , 265 F.3d at 1379.

Similarly, in Orthokinetics, Inc. v. Safety Travel Chairs, Inc., 806 F.2d 1565, 1576 (Fed. Cir. 1986), the Federal Circuit held that a claim term was not indefinite despite the use of general language the application of which would necessarily depend on the circumstances:

> [Claim] 1. In a wheel chair having a seat portion, a front leg portion, and a rear wheel assembly, the improvement wherein said front leg portion is so dimensioned as to be insertable through the space between the doorframe of an automobile and one of the seats thereof . . . .
>
> * * *
>
> The claims were intended to cover the use of the invention with various types of automobiles. That a particular chair on which the claims read may fit within some automobiles and not others is of no moment. The phrase "so dimensioned" is as accurate as the subject matter permits, automobiles being of various sizes. As long as those of ordinary skill in the art realized that the dimensions could be easily obtained, § 112, 2d para. requires nothing more. The patent law does not require that all possible lengths corresponding to the spaces in hundreds of different automobiles be listed in the patent, let alone that they be listed in the claims.

Orthokinetics, 806 F.2d at 1576 (citation omitted).

Thus, in Orthokinetics the Federal Circuit held "so dimensioned" to be sufficiently definite, despite the fact that a chair "so dimensioned" as to fit into one car would not necessarily fit into another car. The Federal Circuit held that it was unnecessary for the patentee to list all of the possible dimensions in the claim, or in the body of the patent itself. This ruling is in direct contrast to Microsoft's methodology.

The district courts have held similarly, rejecting indefiniteness arguments based on claim elements the presence of which depends on external circumstances:

> As with selectivity, whether an antibody has a useful degree of affinity appears to depend on several factors. Genentech's expert, Dr. Unkeless, testified at his deposition that the affinity value required for an antibody to work for purposes of diagnosis may vary depending on the type of assay that is used.
>
> * * *
>
> . . . If, as Dr. Unkeless suggests, it is impossible to define a useful level of affinity by reference to a particular numerical value, the '561 patent cannot be expected - and is not required as a matter of law - to list every possible affinity value that might be useful for every possible purpose of the invention.

> Moreover, simply because a broad range of affinities may be useful does not make the claims indefinite. It is well settled that breadth is not to be equated with indefiniteness." . . . Thus, the claims may permissibly encompass a wide range of affinity values . . . . The relevant question is whether a person of ordinary skill in the art would understand when a monoclonal antibody has an affinity value that is "useful" for the purposes described in the specification.

Chiron Corp. v. Genentech, Inc., No. Civ. S-00-1252, 2002 U.S. Dist. LEXIS 19150, *10-11 (E.D. Cal. June 24, 2002) (citations omitted).[8]

> The Court . . . finds that the term "substantial" as used in the context of paving installations described in the '550 Reissue Patent is sufficiently precise to inform one skilled in the art. . . . in the context of paving installations like those described in the '550 Reissue Patent which can be subjected to a wide variety of loads, it is understood that no explicit quantification can be made for such forces. Thus, the term "substantial" cannot be interpreted to mean a specific quantity; rather it describes a range of loads from pedestrian to vehicular to occasional heavy truck. Dr. Witczak further testified that while tractor-trailers and commercial aircraft would certainly produce "substantial" forces, it is understood from the patent that this invention would not be applied in installation subject to such forces. . . .
>
> * * *
>
> The Court finds that the term "substantial," when considered in the light of the entire claimed invention, is as accurate as the subject matter permits and provides sufficient guidance to one skilled in the art of paving stone installations. . . . Given that pedestrians and vehicles come in a myriad of shapes and sizes, it would be impossible to set forth every possible specific force. Thus, the use of the term "substantial forces" adequately explains that walkways and driveways which incorporate this interlocking paving installation can be subjected to a limited range of forces - from pedestrians up to heavy trucks.

Pave Tech, Inc. v. Snap Edge Corp., 952 F. Supp. 1284, 1301-02 (N.D. Ill. 1996) (citations omitted).

Thus, the case law is clear that patent claims may use general, and even relative, language, where that language is understood by those in the art, and a patentee is not required to provide a comprehensive description of all circumstances in which infringement may be found, but can instead use general language where a comprehensive description would be impractical.

Microsoft's motion is premised on the theory that "secure" is indefinite because determining whether a particular system is "secure" requires an evaluation of the context. MS Memo. at 2:6-18.. As Exxon Research, Orthokinetics, Chiron and Pave Tech make clear, a claim

[8] A copy of this opinion is attached as Ex. R to the Page Decl.

is not rendered indefinite because its application depends on context, nor because it uses general terms that may apply differently in different circumstances.

3. That reasonable persons might disagree regarding the scope of the claims does not render the claims indefinite.

The fact that reasonable people may disagree regarding the application of a claim term does not render that term indefinite:

> It may of course occur that persons experienced in a technologic field will have divergent opinions as to the meaning of a term, particularly as narrow distinctions are drawn by the parties or warranted by the technology. Patent disputes often raise close questions requiring refinement of technical definitions in light of particular facts. The judge will then be obliged to decide between contending positions; a role familiar to judges. But the fact that the parties disagree about claim scope does not of itself render the claim invalid.

Verve, LLC v. Crane Cams, Inc., 311 F.3d 1116, 1120 (Fed. Cir. 2002). See also Exxon Research, 265 F.3d at 1375 (claims not indefinite even if "expert witnesses, trial courts, and even the judges of this court may disagree"). Thus, the fact that InterTrust and Microsoft have proffered similar, but distinct definitions does not suggest that the claims are indefinite.

4. Claims are not indefinite merely because work is required to determine the scope of the claims, as long as such work is not beyond the abilities of one of ordinary skill.

Patent claims are not indefinite merely because determining their scope requires "trial and error" or experimentation, as long as "undue" experimentation is not required:

> The district court invalidated both patents for indefiniteness because of its view that some "trial and error" would be needed to determine the "lower limits" of stretch rate above 10% per second at various temperatures above 35 degrees C. That was error. Assuming some experimentation were needed, a patent is not invalid because of a need for experimentation. . . . A patent is invalid only when those skilled in the art are required to engage in *undue* experimentation to practice the invention. In re Angstadt, 537 F.2d 498, 503-04, 190 U.S.P.Q. 214, 218 (C.C.P.A. 1976). There was no evidence and the court made no finding that undue experimentation was required.

W.L. Gore & Associates, Inc. v. Garlock, Inc., 721 F.2d 1540, 1557 (Fed. Cir. 1983). The test for "undue experimentation" is whether this would require "ingenuity beyond that to be expected of one of ordinary skill in the art." In re Angstadt, 537 F.2d 498, 503-04 (C.C.P.A. 1976).[9]

[9] This case involved enablement, rather than definiteness, but has been cited by the Federal Circuit (e.g., W.L. Gore, cited above) as describing the undue experimentation test applied to indefiniteness.

C. Microsoft's Two-Part Test for Finding Indefiniteness Has Been Rejected By the Federal Circuit.

Microsoft argues that indefiniteness is determined using a two-part test, including whether the claim is "as precise as the subject matter permits" (MS Memo. at 21:9-10) and argues that InterTrust's use of "secure" was not as precise as possible. Memo. at 12:25-13:23.

Microsoft misstates the law. The Federal Circuit has repeatedly held that § 112(2) does not require that claims be drafted as precisely or specifically as possible:

> Claims are often drafted using terminology that is not as precise or specific as it might be. As long as the result complies with the statutory requirement to "particularly point[] out and distinctly claim[] the subject matter which the applicant regards as his invention," 35 U.S.C. § 112, para. 2, that practice is permissible.

PPG Indus., Inc. v. Guardian Indus. Corp., 156 F.3d 1351, 1355 (Fed. Cir. 1998).

> The trial court was correct to fault the Exxon patents as lacking in specificity in several respects--specificity that in some instances would have been easy to provide and would have largely obviated the need to address the issue of indefiniteness. As is often the case when problems in document drafting lead to litigation, the ideal of precision was not achieved here, and we are left to deal with an imperfect product. While we agree with the trial court that the product was less than perfect, we disagree that the flaws were fatal.
>
> * * *
>
> . . . The patentee could easily have cured the ambiguity by adding a single word or phrase to the claims or specification . . . . In fact, much of the extrinsic evidence suggests that the practice in this field of art is to state specifically whether velocity is interstitial or superficial. That practice was not followed in the '982 patent, and the result is that there is some question as to the proper interpretation of the claims. The question we must answer is whether the claims are rendered so ambiguous that one of skill in the art could not reasonably understand their scope. . . .
>
> * * *
>
> If this case were before an examiner, the examiner might well be justified in demanding that the applicant more clearly define UL, and thereby remove any degree of ambiguity. However, we are faced with an issued patent that enjoys a presumption of validity. In these circumstances, we conclude that a person of skill in the art would understand the scope of the term U[L], and that the degree of ambiguity injected into the claims by the patentee's lack of precision is therefore not fatal.

Exxon Research, 265 F.3d at 1376, 1383-84.

Microsoft's argument was discussed in an opinion summarizing Federal Circuit law and concluding that the Federal Circuit does not require that patent claims be drafted as precisely as

the subject matter permits:

> Citing Amgen, Alcon takes the position that a claim must be as precise as the subject matter permits. The court in Amgen did state that "claims must ... be 'as precise as the subject matter permits.'" 927 F.2d at 1217. That statement, however, was contained in a parenthetical characterization of the holding in Shatterproof Glass Corp. v. Libbey-Owens Ford Co., 758 F.2d 613 (Fed. Cir.), cert. denied, 474 U.S. 976, 88 L. Ed. 2d 326, 106 S. Ct. 340 (1985)), but the court in Shatterproof Glass did not actually state that claims must be as precise as the subject matter permits. Rather, the court there stated that "if the claims, read in the light of the specifications, reasonably apprise those skilled in the art both of the utilization and scope of the invention, and if the language is as precise as the subject matter permits, the courts can demand no more.'" Id. at 624 (quoting Georgia-Pacific Corp. v. United States Plywood Corp., 258 F.2d 124, 136 (2d Cir.), cert. denied, 358 U.S. 884, 3 L. Ed. 2d 112, 79 S. Ct. 124 (1958)) (emphasis added).
>
> Were these the only two cases on the issue, there might be some ambiguity as to whether being as precise as the subject matter permits is a necessary, or merely a sufficient, condition for a claim to pass muster under § 112. Federal Circuit cases do not insist on the kind of precision urged by Alcon. The Federal Circuit has never said that all claims must be made as precise as humanly possible, without exception. In fact, in a case decided after Amgen, the court observed that "claims are often drafted using terminology that is not as precise or specific as it might be. As long as the result complies with the statutory requirement to 'particularly point[ ] out and distinctly claim[ ] the subject matter which the applicant regards as his invention,' 35 U.S.C. § 112, para. 2, that practice is permissible." PPG Indus. v. Guardian Indus. Corp., 156 F.3d 1351, 1355 (Fed. Cir. 1998).
>
> The focus, then, is whether, given the nature of the subject matter, the claim is precise enough to make clear to a person skilled in the art what is claimed. There may be times when, for one reason or another, it is impossible, unnecessary, or undesirable to state a claim in terms of precise, quantified measurements. See, e.g., United States v. Telectronics, Inc., 857 F.2d 778, 786 (Fed. Cir. 1988) (district court erred as a matter of law in holding that if claim were read to mean that electric current must be applied "so as to minimize fibrous tissue formation," it would be invalid under § 112 because it would be "impossible to determine when sufficient minimization takes place to determine what current range is involved"), cert. denied, 490 U.S. 1046, 104 L. Ed. 2d 423, 109 S. Ct. 1954 (1989). That is permissible as long as the dictates of § 112 are met.

Bausch & Lomb, Inc. v. Alcon Labs., Inc., 79 F. Supp. 2d 243, 245 (W.D.N.Y. 1999).

Microsoft misstates Federal Circuit law in precisely the same way as the defendant in Bausch & Lomb. Microsoft's two-part indefiniteness test is wrong.

D. The Undisputed Facts Establish that "Secure" and "Security" Are Definite.

1. Use of the term in the industry.

"Secure" and "security" are widely used in the computer security field. Reiter SJ Decl., ¶¶ 5-7. Acceptance of a term by the industry is evidence that use of the term does not render

patent claims indefinite. Rosemount, Inc. v. Beckman Instruments, Inc., 727 F.2d 1540, 1547 (Fed. Cir. 1984); Advanced Cardiovascular Sys., Inc. v. Scimed Life Sys., 96 F. Supp. 2d 1006, 1019 (N.D. Cal. 2000).

2. Use of the term by the defendant in describing its own products.

Microsoft routinely describes its products and features as "secure," both in public documents and in internal documentation. See above, § II A 1(b). The defendant's use of the disputed term supports finding that term not indefinite. Rosemount, 727 F.2d at 1547; Advanced Cardiovascular Systems, 96 F. Supp. 2d at 1019.

3. Use of the term in other patents, including the defendant's patents.

As is described in § II A 3 above, Microsoft's patents use "secure" and "securely" in a manner similar to the InterTrust claims, and these terms are routinely used in claims of third party patents (at least 100 in the past year alone). This supports finding the term to be definite:

> The criticized words are ubiquitous in patent claims. Such usages, when serving reasonably to describe the claimed subject matter to those of skill in the field of the invention, and to distinguish the claimed subject matter from the prior art, have been accepted in patent examination and upheld by the courts.

Andrew Corp. v. Gabriel Electronics, Inc., 847 F.2d 819, 821 (Fed. Cir. 1988).

> Genentech's use of similar terminology without apparent difficulty . . . in its own patent applications, is yet another indication that what is meant by a "useful degree of affinity" is not indefinite. . . .
>
> . . . Genentech's use of the phrase "sufficient affinity" in its own patent application belies its contention that one of ordinary skill in the art would not understand when an antibody has sufficient affinity to be "useful" for therapy.

Chiron Corp., 2002 U.S. Dist. LEXIS 19150, *14-16.[10]

> Indeed, one of Alcon's own witnesses . . . though stating that he did not know what the term "does not substantially inhibit" means in the '607 patent, admitted on cross-examination that several of Allergan's own patents, including some on which Anger himself was named as an inventor, use similar language.
>
> * * *
>
> There was also evidence that Alcon itself has used the word "substantially" in its own patents and in proceedings before the Patent and Trademark Office ("PTO").

Bausch & Lomb, Inc. v. Alcon Labs., Inc., 79 F. Supp. 2d 243, 250 (W.D.N.Y. 1999).

[10] Page Decl., Ex. R.

4. Ability of the Examiner to apply the terms to the prior art.

The PTO Examiners assigned to the InterTrust applications had no difficulty applying the disputed terms (including secure, secure container and protected processing environment) to the prior art. McDow Decl., ¶ 8 and Ex. G. For example, in the Sept. 22, 1998 Notice of Allowance for InterTrust's'019 patent, the Examiner stated that "there is no disclosure [in the prior art Fischer patent] of the recited three secure containers as set forth in the instant claims." He had no difficulty understanding the term "secure containers" or determining whether a "secure container" was disclosed in the prior art. This is one of numerous Patent Office documents quoted in McDow Decl., Ex. G in which Examiners of different InterTrust patents used the term "secure" or a variant and showed that they understood its meaning and were able to apply it.

This supports finding the claims definite. SDS USA, Inc. v. Ken Specialties, Inc., 107 F. Supp. 2d 574, 596 (D.N.J. 2000) (Examiner determining that claim element was found in prior art reference, patent held not indefinite: "SDS accurately surmises from that comment that the 'transfer unit' was readily recognizable to Examiner Crane, and presumably to other skilled professionals, based on mechanisms found in the prior art.").

E. Prof. Mitchell's Analysis Should Be Disregarded, Since He Admittedly Made No Attempt to Understand the Meaning of "Secure" in the Context of the Claims as a Whole.

Prof. Mitchell improperly analyzed the term "secure" in isolation and not in the context of the entire claim in which the term appears. For example, as is described in § II E above, one factor leading Prof. Mitchell to conclude that "secure memory" is indefinite is the fact that the claim does not identify what information other than the digital file is contained in the secure memory, despite the fact that the claim does not require any other information. Prof. Mitchell's explanation revealed that his entire methodology is fatally flawed:

> Q. So, again, sir, is it your testimony that the secure memory recited in '193, claim 1 includes some information other than the digital file?
>
> A. Well, I don't think I have an opinion about it. That sounds like a question about the meaning of the claim, apart from the meaning of the phrase "secure memory."
>
> And, to this point, I haven't really been asked to form a clear

> understanding of the claim and haven't really reflected and done proper study on exactly the question you ask.

Mitchell II 297:2-12.

Thus, Prof. Mitchell believes that "secure memory" is "unclear" in claim 193.1 because (among other things) although the claim indicates a "digital file" is stored in the memory it doesn't identify other information stored in the memory. When asked whether the claim requires such other information, however, he testified that he hadn't studied the claim itself and had no opinion. This testimony was not a momentary aberration:

> Q. Well, does '193, claim 1, require that anything other than the digital file be stored in the secure memory recited in that claim?
>
> THE WITNESS: That sounds like a question about the meaning of the claim rather than a meaning of the phrase "secure memory" to me.
>
> Q. Okay. Does that mean you can't answer the question?
>
> A. To the -- I believe so.

Mitchell II, 298:3-23.

Thus, Prof. Mitchell has no opinion regarding the manner in which "secure memory" is used in the claim, and admits that he doesn't know whether his analysis (e.g., other stored information must be identified) is relevant to the claim, since he hasn't analyzed the claim.

The analysis of indefiniteness begins with the claims themselves:

> Only after a thorough attempt to understand the meaning of a claim has failed to resolve material ambiguities can one conclude that the claim is invalid for indefiniteness. Foremost among the tools of claim construction is of course the claim language itself, but other portions of the intrinsic evidence are clearly relevant, including the patent specification and prosecution history.

All Dental Prodx, LLC v. Advantage Dental Prods., Inc., 309 F.3d 774, 780 (Fed. Cir. 2002).

Prof. Mitchell was not asked to and did not analyze the meaning of the claims and therefore, for example, had no opinion regarding whether one of the elements he felt should be defined as part of "secure memory" was in fact required by the relevant claim. His testimony on indefiniteness was not based on an interpretation of the phrase in the context of the claim. He therefore failed to apply the proper legal standard and his testimony should be disregarded.

F. Microsoft's Evidence, Analogies and Case Support Are Either Irrelevant or Inaccurate.

1. Depositions of third parties.

Microsoft relies heavily on third party testimony regarding the meaning of disputed terms. As is discussed more fully in InterTrust's Motion to Strike, served and filed herewith, these witnesses are not qualified as of ordinary skill in the art, nor have they read the patents, and their testimony is therefore incompetent and should be stricken. If the Court admits this testimony, InterTrust has also included other testimony that establishes that the witnesses understand the disputed terms and can apply them, as well as an explanation of Microsoft's mischaracterization of that testimony. McDow Ex. B, §§ 1(b), 2(b),(c),(d), 3(b),(c).

2. Microsoft's Car and Safe Analogies Are Irrelevant.

Microsoft attempts to convince the Court that "secure" is indefinite because there is no way to know what would be meant if someone characterized a car or a safe as "secure." MS Memo. at 3:13-27; Mitchell Decl., 57-13. These analogies are irrelevant, since the fact that the word "secure" might have no meaning in one context (e.g., a "secure rock") is irrelevant to whether it has meaning in another context in which it is routinely used (e.g., computer security).

3. Microsoft's Argument Relies on Cases that are either Irrelevant or Miscited.

The case discussed at greatest length in Microsoft's brief is Ex Parte Brummer, 12 U.S.P.Q.2d (BNA) 1653 (B.P.A.I. 1989), which Microsoft characterizes as "comparable" to the present case. MS Memo. at 22:13-15. Brummer involved an appeal from a Patent Office decision rejecting patent claims. 12 U.S.P.Q.2d at 1653. The Federal Circuit has warned that the indefiniteness analysis applied to issued patents (e.g., the InterTrust patents) is different than and requires a higher standard than the analysis applied to patent applications (e.g., Brummer). This is the result of the presumption of validity provided to issued patents, a presumption that does not apply to unissued patent applications. Exxon Research , 265 F.3d at 1380. See also, Solomon v. Kimberly-Clark Corp., 216 F.3d 1372, 1378-79 (Fed. Cir. 2000) (different standards applicable to indefiniteness analysis during patent examination and during litigation on issued patent means that evidence properly considered to establish indefiniteness during examination

should not be considered to establish indefiniteness in litigation).[11]

The difference between the indefiniteness standard applied to patent applications and the standard as applied to issued patents is illustrated by the differing outcomes in Brummer and Orthokinetics, cases each involving patent claims drafted in the context of the environment in which the patented item would be used. In Orthokinetics, claims were found definite despite the fact that those claims included an element described as dimensioned so as to fit into an automobile. The Federal Circuit noted that different dimensions would be required for different automobiles, but upheld validity of the claims nevertheless. Orthokinetics, 806 F.2d at 1576.

Microsoft also discusses In re Lechene, 277 F.2d 173 (C.C.P.A. 1960), at some length, arguing that an element discussed in that case ("stiff") is similar to "secure." MS Memo. at 22:6-12. Not only does this case involve an unissued patent application, the decision has nothing to do with definiteness under § 112(2). Instead, the opinion holds that claims were properly rejected as obvious based on a prior art reference. The opinion happens to use the word "indefinite," but in a context having nothing to do with § 112(2).

Microsoft relies on a 1938 case (General Electric Co. v. Wabash Appliance Corp., 304 U.S. 364 (1938)) for the proposition that "claim indefiniteness is particularly problematic where it derives from 'conveniently functional language at the exact point of novelty.'" MS Memo. at 23:7-8. That holding is irrelevant, however, since it involved a principle of claim construction (apparatus claims cannot include functional limitations) that was expressly overruled by the adoption of 35 U.S.C. § 112(6), and since Microsoft makes no argument that InterTrust's claims are indefinite based on inclusion of "functional" language.

Microsoft tries to shoehorn this into an indefiniteness argument by citing Dr. Reiter's testimony for the proposition that "security" is an "essential aspect" of the invention, and arguing that Exxon Research (cited above) stands for the proposition that it is "fatal for limitations critical to patentability to be indefinite." MS Memo. at 23:13-14.

This argument is wrong. First, Microsoft's characterization of Dr. Reiter's testimony is

[11] Microsoft's reliance on In re Cohn, 438 F.23d 989 (C.C.P.A 1971) (MS Memo. at 21:23-25) is misplaced for the same reason, since Cohn also involved an unissued patent application..

completely inaccurate. Reiter SJ Decl., ¶¶ 52-53. Second, Exxon Research contains no such holding. Instead, in Exxon Research the Federal Circuit distinguished an earlier decision on a number of grounds, one of which was the fact that the patent specification in the earlier case had characterized a limitation as critical to patentability, a factor not present in the Exxon Research case. The Federal Circuit noted that the Court of Customs and Patent Appeals had held that it was "not fatal for an applicant to express noncritical limitations with regard to factors such as time or quantity in functional rather than numerical terms." Exxon Research, 265 F.3d at 1379, citing In re Caldwell, 319 F.2d 254, 258 (C.C.P.A. 1963). The Federal Circuit neither stated nor implied that a different indefiniteness standard applies to "critical" limitations.

G. "Protected Processing Environment" and "Host Processing Environment" Are Not Indefinite

1. Protected Processing Environment.

Microsoft's discussion of Protected Processing Environment ("PPE") ignores extensive discussion in the specification. Thus, Microsoft complains that PPE is defined in terms of two other defined terms (HPE and SPE), and that defining one coined term with two other coined terms is "an unhelpful exercise." MS memo. at 18:11-13. Microsoft ignores, however, the specification's detailed description of SPEs and HPEs. Reiter SJ Decl., ¶¶ 39-40, Ex. G.

In addition, Microsoft passes lightly over the figures: "General reference is then made to the PPE in the 'Brief Description of the Drawings' but no meaningful discussion . . . ." MS Memo. at 17:25-26. This statement is false. Several of the drawings are explicitly described as relating to PPEs, and the patents contain dozens of pages describing these drawings. Reiter SJ Decl., ¶ 39-40 and Ex. G. Microsoft ignores all of this.

Prof. Mitchell finds "protected processing environment" indefinite based on his ten-part test. As with "secure," however, he has no difficulty understanding what the term means:

> The protected processing environment likewise shields the information it contains, again through the use of rules governing the access and use of the information. Information apparently cannot be used or accessed by anyone or anything without satisfaction of those associated, governing rules.

Mitchell Decl., 50:20-24.

Again, the issue is not whether InterTrust agrees with Prof. Mitchell's definition. For indefiniteness, the question is whether one of ordinary skill in the art can understand the term. Prof. Mitchell clearly has the ability to do so. His quibbles regarding the failure of the claims to specify every feature that is present (or absent) in a protected processing environment raise the same issues discussed above in connection with his application of his ten-part test to "secure."

2. Host Processing Environment.

Microsoft presents no evidence for its claim that "Host Processing Environment" is indefinite, except that the term was not in general use. Prof. Mitchell does not discuss this term.

Instead of evidence, Microsoft mischaracterizes the InterTrust patents, arguing that the term "host processing environment" is found in only a couple of locations in the patents, and that these locations do not clearly explain what the term means. MS Memo. at 19:7-24.

Microsoft's statement is highly misleading. Although the '900 patent discusses "host processing environments" in only a few locations, it contains extensive description of "HPEs." Reiter SJ Decl., ¶¶ 41-42. Microsoft was aware that the patent uses the acronym "HPE" to refer to Host Processing Environment (MS Memo. at 17:9), but chose to disregard the specification discussion of "HPEs" in favor of arguing that "host processing environments" were only discussed in a few places. This appears to be a deliberate attempt to mislead the Court.

H. The Foundational InterTrust Patent Application is Effectively Incorporated By Reference.

Microsoft seeks a ruling that would effectively invalidate three issued U.S. Patents as a result of a clerical error committed by the Patent Office. Those patents incorporate the original InterTrust application by reference, a procedure explicitly authorized by patent law. Microsoft's sole basis for complaint is that the application number was not later replaced by an issued U.S. patent number. Microsoft implies that this is improper because the original application was not available to those attempting to evaluate the later patents, but this is false, since the earlier application may be obtained from the Patent Office at minimal or no cost. No U.S. Patent has ever been invalidated based on the failure to replace an incorporated by reference application number with a patent number, and Microsoft carries a burden of establishing this issue by clear

and convincing evidence. InterTrust therefore seeks summary judgment on this issue.

According to Microsoft, the original InterTrust patent application is not properly incorporated by reference into three of the later-filed InterTrust patents. Microsoft characterizes the original application as "essential material" to these later patents. Microsoft Memo. at 12:7-9.

A patent that fails to incorporate "essential material" is invalid for lack of enablement. Quaker City Gear Works, Inc. v. Skil Corp., 747 F.2d 1446 (Fed. Cir. 1984). For this reason, Microsoft must establish the failure to incorporate by clear and convincing evidence. Intel Corp. v. Via Technologies, Inc. 319 F.3d 1357, 1366 (Fed. Cir. 2003).

The three InterTrust patents incorporate the earlier application by reference. McDow Decl., ¶ 11. Such incorporation is authorized by the MPEP. See MPEP § 608.01(p), reproduced in the Declaration of Karna J. Nisewaner ("Nisewaner Decl."), ¶ 4 and Ex. 1.

It has long been settled that a patentee's § 112 obligations may be met by materials incorporated by reference, as long as those materials are reasonably available to the public:

> We recognize that, subject to compliance with 35 USC 112 and 132, the disclosure in a patent application may be deliberately supplemented or completed by reference to . . . disclosure in earlier or concurrently filed copending applications, . . . or, in general, to "disclosure which is available to the public," . . . As the expression itself implies, the purpose of "incorporation by reference" is to make one document become a part of another document by referring to the former in the latter in such a manner that it is apparent that the cited document is part of the referencing document as if it were fully set out therein.

In re Lund, 376 F.2d 982, 989 (C.C.P.A. 1967) (citations omitted).

> That total incorporation by reference cannot be accomplished under 112 is apparent from the reading of Lund, Heritage and Stauber. It is limited to reference to material available to the public. This would exclude secret or privileged materials as in the case of some abandoned patent applications. It is reasonable also to exclude materials which are not easily available to the public or the Patent Office. This would include unpublished dissertations and theses, obscure foreign publications and publications to which there are no available English translations.

General Electric Co. v. Brenner, 407 F.2d 1258, 1262-63 (D.C. Cir. 1968).

According to the MPEP, pending or abandoned applications are readily available. Nisewaner Decl., ¶ 4, Ex. 1. The InterTrust application may be obtained from the Patent Office. Nisewaner Decl., ¶¶ 6-9. In addition, the text of the application may be obtained for free in a

matter of minutes through the PTO's on-line service. Nisewaner Decl., ¶¶ 10-11. Microsoft's implication that incorporation of the original InterTrust application by reference was improper because that application is unavailable is false: the application is readily available to the public.

Microsoft argues that the reference to the incorporated InterTrust application should have been replaced with a reference to an issued patent. MS Memo. at 12:19-24. According to MPEP § 608.01(p), the examiner is supposed to replace an application number with the issued patent number. Microsoft cites no support for the argument that issued patents should be invalidated because of what amounts to a clerical mistake by the Patent Office, and it does not appear that any issued patent has ever been invalidated based on this theory. Microsoft cannot possibly carry its burden of showing invalidity by clear and convincing evidence, given the indisputable fact that the application is readily available at low cost. Summary judgment that the application was properly incorporated by reference, and the three patents are therefore not invalid for failure to include essential material is therefore proper.

Even if the foundational application had not been properly incorporated by reference, the later patents contain significant description of the allegedly indefinite terms, description that Microsoft simply ignores. Reiter SJ Decl.,¶ 43, Ex. H.

Microsoft has not carried its burden of establishing that these disclosures lack sufficient information for one of ordinary skill in the art to understand the claims of those patents in light of their specifications. Summary judgment should be entered against Microsoft on this issue.

IV. CONCLUSION

InterTrust respectfully requests that the Court deny Microsoft's motion for summary judgment and grant InterTrust's cross-motion for summary judgment.

Dated: April 7, 2003

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By: _____
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